

AF / IDW



Appellants' Brief on Appeal
U.S. Application Serial No. 10/796,301
(NGB.376)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Jun HAMAKITA et al.

Serial No.: 10/796,301

Group Art Unit: 3611

Filed: March 10, 2004

Examiner: Marc A. Scharich

For: ELECTRIC POWER STEERING DEVICE

APPELLANTS' REPLY BRIEF ON APPEAL

Honorable Commissioner of Patents
Alexandria, Virginia 22313-1450
Box AF

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellants respectfully submit this Reply Brief in response to the Examiner's Answer dated December 16, 2008. Appellants respectfully request entry of this Reply Brief.

I. STATUS OF CLAIMS

Claims 1-5, 10-12, 14, and 16, all of the currently pending claims in the Application, are set forth fully in the attached Appendix.

Appellants previously canceled claims 6-9, 13, and 15.

Claims 1-5, 10, 12, 14, and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Eda, et al. (U.S. Patent No. 5,482,127; hereinafter "Eda") in view of Lewis (U.S. Patent No. 3,234,758).

Appellants' Reply Brief on Appeal
U.S. Application Serial No. 10/796,301
(NGB.376)

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Eda, in view of Lewis, and further in view of Kobayashi, et al. (U.S. Patent No. 6,900,564; hereinafter "Kobayashi").

II. ARGUMENT

In the Examiner's Answer, the Examiner maintained the above rejections on Appeal. Furthermore, the Examiner provided a Response to Arguments in response to the Appeal Brief filed on October 20, 2008.

Appellants stand by the arguments in the Argument section of the Appeal Brief as supplemented by Appellants' below response to the Examiner's Response to Arguments.

Response to Examiner Arguments

Appellants provide the following in the same order as presented by the Examiner in the Examiner's Answer.

Official Notice

In the Examiner's Answer dated December 16, 2008, the Examiner maintains, "The Examiner has never invoked official notice." Appellants disagree.

That is, the Examiner is alleging that the claimed features are "well-known". The only basis that Appellants are aware of for rejecting a claim limitation as being "well-known" is set forth in M.P.E.P. §2144.03 (as detailed in the Appeal Brief filed on October 20, 2008, and through the record, and repeated below). Appellants previously requested the Examiner

Appellants' Reply Brief on Appeal
U.S. Application Serial No. 10/796,301
(NGB.376)

to clarify the rejection and point out support elsewhere in the M.P.E.P. for the Examiner's allegations regarding the alleged "well-known" features. The Examiner, however, was unable to point out such support. Accordingly, Appellants maintain their position.

Indeed, Appellants submit that the Examiner is attempting to establish that features of the claimed invention are "well-known" without support by documentary evidence. Whether the Examiner wishes to refer to this as official notice does not change the effect.

Optimum or Desired Results

In response to Appellants' arguments, the Examiner alleges, "The Examiner has not alleged that using the *specific* grease having the *specific* values of kinematic viscosity and worked penetration, *as claimed*, are well-known (based on the numerical values themselves) but that using an appropriate "off the shelf" grease to achieve optimum or desired results for a specific application (steering device) is well-known and obvious to try." (See Examiner's Answer dated December 16, 2008 at page 8; emphasis by Examiner).

The Examiner, however, has failed to establish the features recited in the claimed invention are result effective variables. Indeed, "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." (See M.P.E.P. §2144.05).

The Examiner has not established the cited references recognized that the claimed features achieved a recognized result, let alone the specific results set forth in the application.

Appellants' Reply Brief on Appeal
U.S. Application Serial No. 10/796,301
(NGB.376)

Moreover, Appellants provide evidence in support of the importance of the specific grease recited in the claims in the Declaration entered into the record on July 17, 2008.

Appellants maintain that it is clearly not appropriate for the Examiner to dismiss the features recited in the claimed invention as being merely "well-known" features.

Accordingly, Appellants respectfully submit that the Examiner's position is clearly unreasonable.

III. CONCLUSION

For the above reasons, as well as the reasons set forth in the Appeal Brief, Appellants respectfully request that the Board reverse the Examiner's rejections of all claims on Appeal. Appellants respectfully request an early and favorable decision on the merits of this Appeal.

Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Attorney's Deposit Account number 50-0481.

Date: February 17, 2009

Respectfully Submitted,



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road
Vienna, Virginia 22182-3817
(703) 761-4100
Customer No. 21254